

Art Unit: 3781

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: page 3, 5<sup>th</sup> paragraph, "[slipped on?]" should be deleted.

Appropriate correction is required.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flanged region that laterally surrounds the cam, as claimed in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it

Art Unit: 3781

is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 5-8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure lacks support for an embodiment wherein there is a cut and an area of reduced thickness. Examiner notes the Specification enables the cuts can (but do not necessarily have to be) formed of an area of reduced wall thickness. It would appear the area of reduced thickness, if there is one present, is a cut, itself. Thus, for purposes of examination, the area of reduced thickness will be treated as a different vertical slit from the "at least one vertical cut."

Furthermore regarding claim 2, Examiner asserts there is no support in the Specification for the claimed structure. The Specification enables cuts to instead be formed of regions of reduced wall thickness, i.e. scores, but does not enable a region of the guarantee ring being formed of reduced thickness between cut lines.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hadley US 3,910,443.

Examiner notes the claim is drawn to a capping system for a container with a mouth. In other words, the claim is only positively drawn to the closure. Therefore, the closure must only be capable of being used in the intended manner. In the instant case, because the closure of Hadley '443 meets all claimed structural features of the cap, it is inherently capable of being used in the intended manner. It

Art Unit: 3781

has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Hadley '443 teaches an aluminum cap comprising a bottom for covering the mouth, a jacket, a guarantee ring defined by a horizontal score (5), and a vertical score (4), a second of which scores is read to be the area of reduced thickness, and which is taught in column 3, line 10 to be formed of aluminum. Because the cap meets all claimed structural features, it will inherently perform as claimed, if applied onto a container neck such as that of the instant claims.

Furthermore regarding claim 8, Examiner contends the claim limits that a stopper "can be inserted into the mouth of the container." This is not held to be a positive recitation of such structure (which would comprise more definite language, such as "is insterted..."). Thus, Examiner asserts the prior art need not require a stopper in order to properly anticipate the claim.

7. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kutcher US 3,601,273.

Examiner notes the claim is drawn to a capping system for a container with a mouth. In other words, the claim is only positively drawn to the closure. Therefore, the closure must only be capable of being used in the intended manner. In the instant case, because the closure of Hadley '443 meets all claimed structural features of the cap, it is inherently capable of being used in the intended manner. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Kutcher '273 teaches an aluminum cap comprising a bottom (10) for covering the mouth, a jacket (11), a guarantee ring defined by a horizontal score (14), a vertical score (18), a second of which scores is read to be the area of reduced thickness, and which is taught in column 1, lines 50-57 to be the same type of closure as that of US patent 3,303,955, which is taught in column 1, line 16 of the same document

Art Unit: 3781

to be formed of aluminum. Because the cap meets all claimed structural features, it will inherently perform as claimed, if applied onto a container neck such as that of the instant claims.

Furthermore regarding claim 8, Examiner contends the claim limits that a stopper "can be inserted into the mouth of the container." This is not held to be a positive recitation of such structure (which would comprise more definite language, such as "is insterted..."). Thus, Examiner asserts the prior art need not require a stopper in order to properly anticipate the claim.

8. Claims 11-14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabrice US 2,113,176.

Examiner notes the claim is drawn to a capping system for a container with a mouth. In other words, the claim is only positively drawn to the closure. Therefore, the closure must only be capable of being used in the intended manner. In the instant case, because the closure of Hadley '443 meets all claimed structural features of the cap, it is inherently capable of being used in the intended manner. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus, the limitations of claim 5, 7, and 8 may not necessarily be found in Fabrice; however, the closure must only be capable of being used in the intended manner, i.e. with a container neck having such structures.

Fabrice '176 teaches a closure having an end cap (unlabeled), a jacket (5) extending from the end cap, a guarantee ring (6), a predetermined rupture line (along 7, 8), at least one cam (4), at least one vertical cut (9), and a flanged region (6, in figure 6) which laterally surrounds the cam. Regarding claim 9, the reference teaches the cap is first placed on the neck, and then pressed around the threads, and the guarantee ring is flanged such that it laterally overlaps the cams.

Furthermore regarding claim 8, Examiner contends the claim limits that a stopper "can be inserted into the mouth of the container." This is not held to be a positive recitation of such structure (which would comprise more definite language, such as "is insterted..."). Thus, Examiner asserts the prior art need not require a stopper in order to properly anticipate the claim.

Art Unit: 3781

Regarding claim 11, Examiner notes the cap must only be capable of being used in the intended manner, i.e. the guarantee must only be capable of being rotated relative to the cam (which isn't claimed, but which is argued in the Remarks). Examiner notes such relative rotation could be obtained with a smaller cam, such as if the cap were applied to a different container. Furthermore, Examiner reads projections (6, in figure 6) as the flanged regions which surround the cam.

Regarding claim 12, the cap is capable of being used in the intended manner, i.e. on a different cam which would force the guarantee radially outwardly.

Regarding claims 13-14, the reference teaches cut (9), which is severed upon rotation.

Regarding claim 16, the cam has sloped sides, in that they approach corners (4) at an angle.

Regarding claims 17-18, the cap is capable of being used in the intended manner.

Regarding claim 19, the cap is disposed above the cam and below the mouth.

Regarding claim 20, the flanged region (6) is adjacent the weakened cut (9).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 15 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Fabrice US 2,113,176, as applied above to claim 9, and further in view of Kutcher US 3,601,273.

Fabrice '176, as applied above, teaches all limitations substantially as claimed, but fails to teach the cut line being formed substantially parallel to a longitudinal axis of the cap, and a plurality of cut portions.

Kutcher '273 teaches a plurality of vertical cut lines in a guarantee ring, which are designed to fracture upon opening of the closure, to indicate tampering.

Art Unit: 3781

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guarantee ring of Fabrice '176, providing a plurality of vertical cut lines, as taught by Kutcher '273, motivated by increasing the number of points at which the ring will fail upon opening.

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) “by holding that courts and patent examiners should look only to the problem the patentee was trying to solve ” (*Id.* at \_\_\_, 82 USPQ2d at 1397); (2) by assuming “that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem” (*Id.*); (3) by concluding “that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try” (*Id.*); and (4) by overemphasizing “the risk of courts and patent examiners falling prey to hindsight bias” and as a result applying “[r]igid preventative rules that deny factfinders recourse to common sense” (*Id.* ). In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at \_\_\_, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at \_\_\_, 82 USPQ2d at 1395.

Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (B), it is obvious to combine known elements in a predictable manner.

### ***Response to Arguments***

11. Applicant's arguments filed September 9, 2009 have been fully considered but they are not persuasive.

Art Unit: 3781

**Applicant argues that each of Hadley, Kutcher, and Fabrice all fail to teach an area of reduced thickness in an area that surrounds a cam.**

Examiner notes there is no support for such a feature in the Specification. Page 5 of the Specification (which is marked page 4) describes the reduced thickness being an alternative to cuts which go all the way through the ring. In other words, the reduced thickness is a score line, in place of a cut line. Examiner encourages Applicant to show where support can be found for a region of reduced thickness, i.e. a circumferential segment. Examiner notes the figures fail to show any form of reduced thickness on the guarantee ring.

**Applicant argues Fabrice fails to teach a flanged region.**

Examiner notes the guarantee ring of Fabrice is bent in four locations to create flanges which surround the guarantee ring. Examiner furthermore notes none of the figures show the instant flanged region.

**Applicant argues Fabrice fails to teach relative movement between the guarantee and the cam.**

Examiner notes the claim is only drawn to the cap, with the intended use of being applied to a container with a cam. Thus, the device must only be capable of being used in the intended manner. In this case, the cap of Fabrice could experience relative rotation, were it to be applied to a container with a smaller cam.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

Art Unit: 3781

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/  
Supervisory Patent Examiner, Art Unit  
3781

/James N Smalley/  
Examiner, Art Unit 3781